

REMARKS

These remarks are set forth in response to the Non-Final Office Action. As this amendment has been timely filed within the three-month shortened statutory period, neither an extension of time nor a fee is required. At the time of the Non-Final Office Action, Claims 1 through 29 were pending and rejected in this application. Claims 1, 11, and 20 are independent. Applicants have withdrawn claims 11-29 to remove these claims from further consideration in this application. Applicants are not conceding in this application that these claims are not patentable over the prior art cited by the Examiner, as the present claim withdrawals are only for facilitating expeditious prosecution of the present application. Applicants respectfully reserve the right to pursue these and other claims in one or more continuations and/or divisional patent applications.

CLAIMS 1-29 ARE REJECTED UNDER U.S.C. § 103 FOR OBVIOUSNESS BASED UPON MARX ET AL., U.S. PATENT NO. 6,173,266 (HEREINAFTER MARX), IN VIEW OF ZIRNGIBL ET AL., U.S. PATENT NO. 7,266,181 (HEREINAFTER ZIRNGIBL)

On pages 2-7 of the Non-Final Office Action, the Examiner asserted that one having ordinary skill in the art would have been realistically impelled to modify Marx in view of Zirngibl to arrive at the invention corresponding to that claimed in Claims 1-29. This rejection is respectfully traversed.

Obviousness is a legal conclusion based on underlying factual determinations of four general types, all of which must be considered by the trier of fact: (1) the scope and content of the prior art; (2) the level of skill in the art; (3), the differences between the claimed subject

matter and the prior art; and (4) any objective indicia of nonobviousness.¹ Applicants' position is that the Examiner has not properly established the underlying facts regarding (1) the scope and content of the prior art and (3) the differences between the claimed invention and the prior art. Thus, the Examiner has improperly arrived at the legal conclusion that the claimed invention is obvious based upon Marx in view of Zirngibl.

Claim 1

Independent claim 1, in part, recites "presenting a style-selection menu that allows for selection of one or more catch styles, each catch style corresponding to a system response to a catch event, the catch event comprising at least one event in which a user entry is not understood occurring during a dialog turn, the event being selected from the group consisting of a user request for help, a non-input entry, and a non-matching entry." To teach these limitations, on pages 5-6 the Office Action, the Examiner asserted the following:

Concerning independent claims 1, 11, and 20, the only **elements not expressly disclosed by Marx et al. are the concepts of "style"-selection and "catch styles"**... However it is known in the art of voice services to provide style sheets to create interactive voice services to provide style sheets to create interactive voice services. Specifically, Zirngibl et al. teaches a system and method for creation and automatic deployment of personalized dynamic and interactive voice services, where XML (extensible style sheet language) style sheets are provided to create voice services. An objective is to maximum an administrator's voice service building capability. (Column 11, Lines 32 to 49) It would have been obvious to one having ordinary skill in the art to apply a concept of "style" to selection of "catch styles" as taught by Zirngibl et al. in a Dialogue Module selection method of Marx et al. for a purpose of maximizing an administrator's voice service building capability. (emphasis added).

¹ See KSR Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007); Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966); Continental Can Co. USA, Inc. v. Monsanto Co., 948 F.2d 1264, 1270, 20 USPQ2d 1746, 1750-51 (Fed. Cir. 1991); Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1566-68, 1 USPQ2d 1593, 1594 (Fed. Cir. 1987).

Applicants agree with the Examiner, “Marx *et al.* does not specifically teach the “presenting a style-selection menu that allows for selection of one or more catch styles, each catch style corresponding to a system response to a **catch event**, the catch event comprising at least one event in which a user entry is not understood occurring during a dialog turn, the event being selected from the group consisting of a user request for help, a non-input entry, and a non-matching entry.”

As to the Examiner’s obviousness analysis with respect to Marx, Applicants respectfully disagree that one of ordinary skill in the art would be impelled to modify Marx in view of Zirngibl to provide “style-selection” and “catch styles” for “catch events” as provided for by Applicants’ claimed invention. For instance, the presenting a style-selection menu that allows for selection of one or more catch styles is not necessary for the invention of Marx, as Marx is NOT interested in presenting a style-selection menu that allows for selection of one or more catch styles. In this regard, Applicants note that one of ordinary skill in the art would not be impelled to modify Marx in view of Zirngibl by performing phonetic sorting of phonetic representations. Accordingly, the Examiner has not asserted a realistic rationale that would have led one having ordinary skill in the art to the claimed invention. Instead, the Examiner has merely restated the missing limitation as the reason for including the missing limitation (i.e., circular reasoning, e.g., it would have been obvious to include the missing limitation for the purpose of including the missing limitation). Thus, Marx in view of Zirngibl fails to teach or suggest the limitation of “presenting a style-selection menu that allows for selection of one or more catch styles, each catch style corresponding to a system response to a catch event, the catch

event comprising at least one event in which a user entry is not understood occurring during a dialog turn, the event being selected from the group consisting of a user request for help, a non-input entry, and a non-matching entry” as recited in claim 1, within the meaning of 35 U.S.C. § 103.

Moreover, the Examiner's cited passage, however, fails to refer to the specific teachings within Zirngibl that the Examiner is relying upon to modify Marx. Instead, this cited passage appears to be a general description of the benefits obtained by using the entirety of the teachings of Zirngibl. Therefore, the Examiner has failed to establish a nexus between the specific proposed modifications to Marx, as allegedly taught by Zirngibl, and the alleged benefits.

Without requiring a nexus between the proposed modification and the asserted benefit of the modification, the Examiner could assert that any possible modification taught by Zirngibl could be based upon any possible benefit taught by Zirngibl. The need for a nexus between the proposed modification and the asserted benefit of the modification is to establish that one having ordinary skill in the art would have been realistically impelled to modify the prior art in the manner suggested by the Examiner. Thus, for the reasons stated above, Appellants respectfully submit that the Examiner has failed to set forth a prima facie case of obviousness for lack of a proper rationale to modify Marx in view of Zirngibl.

Conclusion

Thus, the Applicants believe that claims 1-10 distinguish over the cited art and stand patentable and ready for an indication of allowance. To that end, the Applicants respectfully request the withdrawal of the rejections under 35 U.S.C. § 103 owing to the foregoing remarks. This entire application is now believed to be in condition for allowance. Consequently, such action is respectfully requested. The Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 50-3839, and please credit any excess fees to such deposit account.

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Respectfully submitted,

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